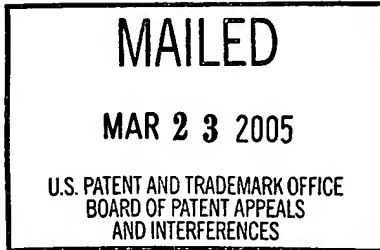


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte JOYCE BRETT

Appeal No. 2005-0483
Application No. 10/029,818

ON BRIEF

Before FRANKFORT, MCQUADE and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

REMAND TO THE EXAMINER

This application is remanded to the examiner pursuant to 37 CFR § 41.50(a)(1) for clarification as to the status of the rejection under 35 U.S.C. § 112, first paragraph.

In the final rejection mailed December 24, 2003, the examiner rejected claim 1 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, and rejected claim 1 under 35 U.S.C. § 103.

Appellant's brief, filed February 25, 2004, provides arguments on pages 3 and 4 as to why the rejection under 35 U.S.C. § 112, first paragraph, should be reversed and provides arguments on page 4 as to why the rejection under 35 U.S.C. § 103 should be reversed.

The examiner's answer mailed April 27, 2004 repeats both the rejection under 35 U.S.C. § 112, first paragraph, and the rejection under 35 U.S.C. § 103. The examiner responds to the arguments in appellant's brief with regard to the rejection under 35 U.S.C. § 112, first paragraph, on pages 6 and 7 of the answer. Having read the entirety of that response to arguments, it appears to us that the examiner did not find appellant's arguments persuasive and provided an explanation as to why the rejection was being maintained.

Appellant filed a reply brief on May 11, 2004. On page 1 of the reply brief, appellant states that the rejection under 35 U.S.C. § 112, first paragraph, "is apparently withdrawn in view of the clarification provide[d] in applicant's BRIEF OF APPLICANT as stated in paragraph (11) RESPONSE TO ARGUMENT on page 6,7."

The examiner issued a communication, mailed June 25, 2004, stating that "[t]he reply brief filed May 11, 2004 has been entered and considered." That communication was silent with regard to the status of the rejection under 35 U.S.C. § 112, first paragraph.

The examiner's election not to respond to the appellant's statement in the reply brief that the rejection under 35 U.S.C. § 112, first paragraph, is apparently withdrawn, after having entered and considered that reply brief, leaves the record unclear as to whether appellant was in fact correct that the rejection is withdrawn. On the one hand, the examiner's response to arguments in the answer appears to us to indicate that the rejection is maintained. On the other hand, if the examiner considered appellant's statement in the reply brief as to the status of the rejection under 35 U.S.C. § 112, first paragraph, to be incorrect, we would expect that the examiner would have clarified that point on the record.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office

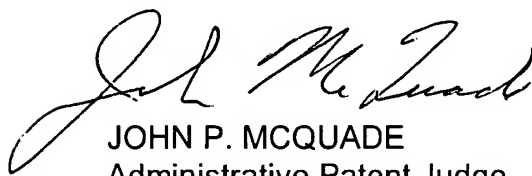
21 (September 7, 2004)) is **not** made for further consideration of a rejection.

Accordingly, 37 CFR § 41.50(a)(2) does not apply.

This application, by virtue of its "special" status, requires an immediate action.
See Section 708.01(d) of the *Manual of Patent Examining Procedure*, 8th Edition, Rev.
1, February 2003. The Board should be promptly informed of any action affecting the
status of this appeal (e.g., abandonment, allowance, reopening of prosecution).

REMANDED


CHARLES E. FRANKFORT
Administrative Patent Judge


JOHN P. MCQUADE
Administrative Patent Judge


JENNIFER D. BAHR
Administrative Patent Judge

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Appeal No. 2005-0483
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